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U.S. PATENT & TRADEMARK OFFICE

Appeal No. 2006-1308
(Serial No. 09/612,821)

FILE COPY

**IN THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

IN RE PAUL C. ZIMMER

**APPEAL FROM A DECISION OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE BOARD OF PATENT APPEALS AND
INTERFERENCES**

**BRIEF FOR APPELLANT
PAUL C. ZIMMER**

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June 6, 2006

mlf

CERTIFICATE OF INTEREST

The undersigned counsel of record for applicant-appellant, Paul C.

Zimmer, furnishes the following list in compliance with Rule 8:

- (a) Paul C. Zimmer
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TABLE OF CONTENTS

Certificate of Interest	ii
Table of Cases, Statutes, and Other Authorities	v
Statement of Related Cases	vi
Statement of Jurisdiction	vi
Statement of the Issues	1
Statement of the Case	2
Statement of the Facts	2
The Invention	2
The Rejected Claims	4
The Proceedings Below	6
Summary of the Argument	9
Argument	12
A. STANDARD OF REVIEW	12
B. THE RECITATION OF THE PRINTED NAME OF THE RECIPIENT IN CLAIMS 1-3 SHOULD BE GIVEN PATENTABLE WEIGHT	13
1. The Prior Decisions On Non-functionality Do Not Support The Rejection Of Claims 1-3	13
2. The Board Decision Defined The Structure Which Must Be Functionally Related To The Printed Matter Too Narrowly..	15
C. THE PRINTED MATTER IN METHOD CLAIMS 4 AND 5 SHOULD BE GIVEN PATENTABLE WEIGHT	16

1. Method Claims Are Not Subject To The Nonfunctionality Test.	16
2. Even If Subject To The Nonfunctionality Test, Claims 4 And 5 Recite Printed Matter Which Is Functionally Related To The Other Steps Of The Claimed Method	17
Conclusion	19
Addendum	

TABLE OF CASES, STATUTES, AND OTHER AUTHORITIES

CASES

PAGE(S)

<u>In re Ngai</u> 367 F.3d 1338, 70 USPQ2d 1862 (Fed Cir 2004)	8, 13, 14
<u>In re Gulack</u> 703 F.2d 1381, 1386, 217 USPQ 401 (Fed Cir 1983)	8, 13
<u>In re Lowry</u> 32 F.3d 1579, 32 USPQ2d 1031 (Fed Cir 1994)	13
<u>In re Miller</u> 418 F.2d 1392, 164 USPQ 46(CCPA 1969).	13

RULE

1) Manual of Patent Examining Procedure, Chapter 2106, VI.	7
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STATUTES

35 USC § 103(a)	6, 7, 12
35 USC § 102 (b).	7, 12

STATEMENT OF RELATED CASES

There are no related cases in this court, either pending or dismissed.

STATEMENT OF JURISDICTION

Jurisdiction of this Court to hear this Appeal is based on Title 28

USC § 1295(a)(4) and Title 35 USC §141.

STATEMENT OF THE ISSUES

1. Is there a new and unobvious functional relationship between the recipient name printed on each page of a daily calendar as recited in rejected claims 1-3 and the underlying claimed calendar?

2. Is the rule that precludes giving patentable weight to the content of printed matter which does not have a new and unobvious functional relationship to the underlying object applicable to the rejected method claims?

3. If the nonfunctionality rule is applicable to method claims, does the step of imprinting the recipient's name as recited in rejected claims 4 and 5 have a new and unobvious functional relationship to the other recited steps?

STATEMENT OF THE CASE

This is an Appeal of a decision on a Request for Reconsideration by the Board of Patent Appeals and Interferences dated December 15, 2005, upholding the Examiner's rejection of claims 1-5 in the application at issue in this appeal. Appellant filed a Notice of Appeal in the U.S. Patent and Trademark Office on February 15, 2006. Jurisdiction is based on Title 28 USC § 1295 (a)(4) and Title 35 USC § 141.

STATEMENT OF THE FACTS

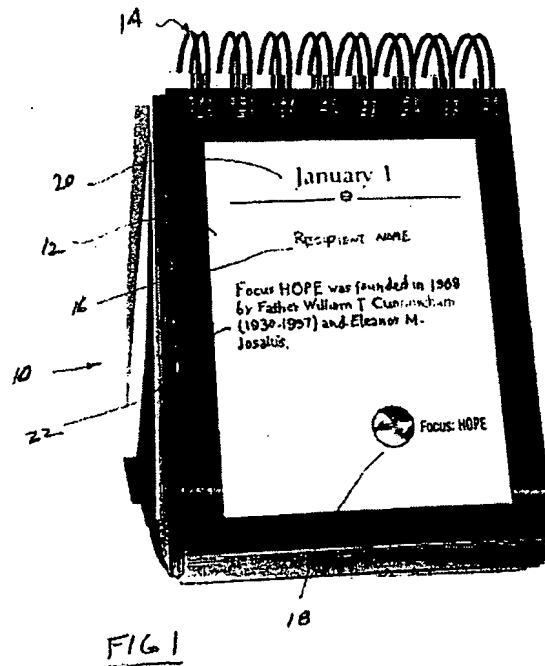
THE INVENTION

The present invention comprises a personalized daily calendar and a method involving the distribution of the personalized daily calendar, which calendar has a separate page for each day of the year, and in which each calendar page is prominently imprinted with the name of the recipient as well as an identifier of the enterprise to be promoted.

The prominent appearance of the recipient's name on every page attracts the attention of the recipient and its juxtaposition with the enterprise identifier creates a favorable mental association effect (the enterprise identifier also appearing on that page), which favorable effect is reinforced daily as the

user turns to the next day's page. The recipient is constantly impressed with the value set on the relationship by the enterprise. (A6 and A7, see also A 67).

This calendar is shown in Figure 1, (A 12) reproduced below.



The daily calendar 10 is of a type in which each day of the year is imprinted on a separate one of the calendar pages 12, the pages 12 held together as by a wire ring binding 14. This allows each page 12 to be turned, allowing display of the next day page 12B (Figure 2). The calendar 10 may be of the "perpetual" type, i.e., the day of the week and holiday notations omitted to allow multi year use, although this is optional.

Each page 12 has a prominent imprint 16 of the name of an intended recipient, preferably in a central location and in large type just below the printed date 20 to be conspicuously displayed on each page.

This personalizes the calendar 10 to the recipient. Each page also bears a prominently displayed imprint 18 of the name, logo or other identifier of the enterprise, here Focus Hope, a non profit enterprise operated in Detroit, Michigan.

A text message 22 may also be printed on each page, which may be specific to the enterprise, in the example shown concerning the founding of Focus Hope, and are different on each page 12B (22C, Figure 2 A 13).

Alternatively, the message 22C (Figure 3) may be of unrelated content, but attracting the interest of the user to encourage him or her to look at each page. (A 8 and 9).

THE REJECTED CLAIMS

1. A promotional calendar comprising:
 - a series of pages each imprinted with a respective day of the year and held together to allow turning or tear off of each page;
 - each page prominently printed with the name of a person to personalize each page of the calendar;

each page also prominently printed with an identifier of an enterprise to be promoted, whereby said person's name and said enterprise identifier are visually associated on each page.

2. The calendar of claim 1 wherein a text message is also imprinted on each calendar page differing from the text messages of the other pages.

3. The calendar of claim 2 wherein only the date is printed on each page to provide a perpetual calendar.

4. A method of promoting an enterprise to select individuals comprising the steps of prominently printing the name of each such individual on each page of a daily calendar having a separate page for each day;

imprinting an enterprise identifier on each page of said daily calendar so as to visually associate said printed name and said enterprise identifier on each page thereof; and

distributing said daily calendar to each of said individuals

5. The method according to claim 4 further including the step of imprinting a different message relating to the enterprise on each page of said daily calendar. (A 71 and 72).

THE PROCEEDINGS BELOW

This Appeal follows after two decisions of the Board of Patent Appeals and Interferences and a decision by the Board on a Request for Reconsideration of the later of those two decisions.

A first Appeal to the Board of Patent Appeals and Interferences resulted in a decision dated April 24, 2003 (A 44) reversing the Examiner's Final Rejection of claims 1 to 5 under 35 USC § 103(a) as unpatentable over Hallam (U.S. Patent No. 964,967)(A90) in view of Deaton (U.S. patent no. 1,427,786) (Office Action of January 31, 2002) (A24).

The Board's opinion is noteworthy in that the Board explicitly stated that:

... it is our view that the teachings of Deaton would have made it obvious to one of ordinary skill in the art at the time of the invention was made to have a personalization such as the name of the person to whom the calendar is presented, and the name of the donor on only the permanent part of the calendar of Hallam, and not on each of a plurality of pages as recited in the claims. (emphasis added) (A 47)

The Board thus agreed that these claims would not have been obvious to one of ordinary skill in the art in view of Deaton and Hallam, and reversed the Examiner's rejection of claims 1-5 on obviousness grounds.

The Board's opinion did include a remand statement to the effect that the Examiner should consider:

. . . whether the printed recipient's name recited in the claims on appeal is 'printed matter', and if so whether or not it is functionally related to the substrate in a new and unobvious way so as to distinguish over the prior art in terms of patentability. (A48)

The opinion referred the Examiner to the Manual of Patent Examining Procedure MPEP §2106 (Eighth Edition, Revision 1, Feb. 2003) and specifically section VI entitled "Determine Whether the Claimed Invention Complies with 35 USC § 102 and 103" (A 48).

That section of the MPEP deals with "nonfunctional descriptive material", *i.e.* printed descriptive material that is not functionally related to the claimed combination (and also assertedly to a claimed process).

On remand, the Examiner again rejected all of the claims over the Hallam U.S. Patent No. 964,467 (A90), stating that even though the imprinting of each page of the calendar with a recipient's name was not found in Hallam, this difference constituted nonfunctional descriptive material, and could not serve to establish patentability of the claims under the cited holdings of this Court (A 53, 54). This rejection was made final by the Examiner in an Office Action dated December 17, 2003 (A 61) but on the stated basis that it would have been obvious to imprint the name of a recipient on each page of the Hallam calendar, and that under 35 USC § 103(a), all of the claims were unpatentable (A 64).

This rejection was appealed by the applicant, and in a decision dated October 25, 2005 (A 78) the Board of Patent Appeals and Interferences again acknowledged the novelty and usefulness of the feature in claim 1 of a recipient's name printed on each page of a daily calendar (A82).

Nonetheless, since the Board considered this feature as nonfunctional descriptive material that should be denied consideration, i.e., not given any patentable weight, the Board thus held claim 1 to be unpatentable, citing In re Ngai 367 F3d 1336, 1338, 7011 USPQ2d 1862 (Fed Cir 2004) and In re Gulack 703 F2d 1381, 1386, 217 USPQ 401 (Fed Cir 1983).

The Board's opinion focused on the relationship of the printed material to the pages of the calendar and stated that the imprinting of the recipient's name on each page was the same as the relationship of the printed material of the Hallam calendar to the pages of that calendar.

Since Appellant-applicant grouped all of the claims 1-5 together in his Appeal Brief (A68), the rejection of the method claims 4 and 5 was likewise affirmed.

A request for Reconsideration was duly filed by Appellant-Applicant on November 25, 2005 which included a request that Appellant-Applicant be allowed to withdraw the grouping of all of the claims together and

that method claims 4 and 5 be considered on their merits since the Board affirmance differed in an important respect from the Examiner's final rejection.

That is, the Examiner's rejection also stated that it would have been obvious to add an imprint of the recipient's name to each page of Hallam's calendar, while the Board's decision held that the recitation of the imprinted recipient's name on each page should be disregarded in determining patentability while specifically stating this was not an obvious difference with Hallam.

The Board of Patent Appeals and Interferences in a decision dated December 15, 2005 on the Request for Reconsideration did agree to consider method claims 4 and 5 on their merits, but impliedly held that the imprinting step recitation in claims 4 and 5 was also subject to the "nonfunctional descriptive material" rule as well, and this step should be denied consideration, such that claims 4 and 5 were unpatentable over Hallam.

SUMMARY OF THE ARGUMENT

As to the product claims 1-3, the Board of Patent Appeals and Interferences erred in construing the imprint of the recipient's name as "nonfunctional descriptive material" which can properly be disregarded in determining patentability since the Board too narrowly defined the structure

with which the new and unobvious functional relationship with the printed matter must exist.

That is, the Board looked to see if a new and unobvious functional relationship existed between the imprinted recipient name and the substrate, i.e., each page of the calendar.

The proper structure to consider is not merely a “substrate”, i.e., a page on which the imprint is made, but the entire “underlying object”, i.e. a daily calendar having each page also imprinted with an enterprise identifier. The new and unobvious function is producing a daily visual juxtaposition of the recipient and enterprise names to create a mental association between the two in the mind of the recipient of the calendar when he or she turns to the page for the next day.

As to method claims 4 and 5, there is no basis in the case law for applying the non-functionality rule of Gulack to method claims in general and to rejected claims 4 and 5 in particular. The test as stated in Gulack and the other cases dealing with the issue, requires a “new and unobvious functional relationship” to be found between the content of printed matter and the structure or object with which it is combined. Thus, the rule has previously only been applied to combination claims, and not to method claims.

Even if the test was extended to apply to method claims, the content of the printed matter of claims 4 and 5 is functionally related to the other steps of the process in a new and unobvious way, and indeed, the steps recited require the particular content of the printed matter recited, i.e. the imprinted name of the recipient in order to produce the intended promotional effect of the method.

Finally, since the Board of Patent Appeals and Interferences has recognized in its opinions that the imprint of a recipient name on each page of a daily calendar also having each page imprinted with an enterprise identifier, is a new and unobvious combination and method, claims 1-5 are respectfully urged to be patentable, since this limitation should be given patentable weight in making this determination.

ARGUMENT

A. STANDARD OF REVIEW

Nominally, the rejection of claims 1-5 by both the Examiner and the Board was based on 35 USC § 103(a), and the standard of review would be de novo.

However, the substance of the rejection is logically based on anticipation by Hallam under 35 USC § 102 (b) if the content of the printed matter comprised of the recipient's name is disregarded. Anticipation is normally reviewed under the substantial evidence standard. However, since the legal issue of whether the printed matter content is to be given patentable weight is controlling, it is urged that a de novo review is proper nonetheless.

The Board did find that there is no new and unobvious functional relationship between the printed matter content and the substrate, a "substantial evidence" issue. However, Appellant-Applicant urges that that is not the proper test, but rather does that relationship exist between the content of the printed matter and the underlying object i.e., the daily calendar as claimed, and not merely with the page on which the printed matter appears. Accordingly, a de novo review of that issue is urged to be the proper standard of review.

**B. THE RECITATION OF THE PRINTED NAME OF THE RECIPIENT
IN CLAIMS 1-3 SHOULD BE GIVEN PATENTABLE WEIGHT**

**1. The Prior Decisions On Non-functionality Do Not Support The Rejection Of
Claims 1-3**

The Board of Patent Appeals and Interferences in its two opinions have cited three decisions of this Court in support of its holding that the content of the printed matter constituted by the recipient's name should not be given any weight in determining patentability, In re Gulack 703 F. 2nd 1381, 217 USPQ 401 (Fed Cir 1983); In re Lowry 32 F.3d 1379, 32 USPQ2d 1031 (Fed Cir 1994); and, In re Ngai 367 F. 3d 1336, 70 USPQ2d 1862 (Fed Cir 2004). In re Gulack in turn cited In re Miller 418 F.2d 1392, 164 USPQ 46 (CCPA 1969), as this case held that if printed matter is functionally related to a device on which the printed matter is placed, the content of the printed matter must be considered in evaluating patentability.

The Miller Court found that there was a new and unobvious relationship between a receptacle, and indicia thereon indicating volume in a certain ratio to actual volume, and a legend indicating the ratio.

The Miller Court held that since this relationship was specified by the language of the claim, the indicia and legend must be considered in determining patentability.

That is, as characterized by the opinion in In re Gulack, the Court found that the printed matter of Miller's invention was functionally related to the volume measuring device.

In re Gulack dealt with a decision by the Court reversing a Board decision affirming an Examiner's rejection in which the recitation in a claim of the content of printed matter was not given any weight because of an asserted lack of a functional relationship between the content of the printed matter and a substrate comprise of a looped band.

As noted in In re Lowry (supra), this Court criticized the U.S. Patent and Trademark Office for erroneously attempting to extend this type of printed matter rejection to information stored in memory despite a previous cautioning in Gulack that printed matter rejections stand on "questionable legal and logical footing" and should not be liberally applied.

Of these four cases, only in In re Ngai 367 F.3d 1336, 70 USPQ 2d 1862 (Fed Cir 2004) did this Court uphold such a printed matter rejection on the basis that the content of printed matter did not have any new or unobvious functional relationship with the "underlying object".

In Ngai, a known RNA extraction kit was claimed in combination with a printed instruction sheet which merely described a new RNA extraction method which method was claimed in other claims. That new method as well as

conventional methods could be practiced with a prior art kit which was recited in the rejected claim.

This Court held that this combination could not be patented since the content of the claimed printed instructions and the claimed prior art kit were not functionally related inasmuch as the kit could be used with other conventional methods.

2. The Board Decision Defined The Structure Which Must Be Functionally Related To The Printed Matter Too Narrowly

The Board opinion recognizing its Decision on Reconsideration of December 15, 2006 states in two places that:

. . . there does not exist any new and unobvious functional relationship between the printed matter and the substrate. (emphasis added) (A2)

In the original decision of Oct. 25, 2005 the opinion states:

While it may be true that the appellant's printed matter (i.e., the name of a person to personalize the calendar and an enterprise identifier) creates a mental association, the functional relationship between the printed matter and the pages of the calendar is the same relationship as depicted in Hallam. It is the functional relationship of the printed matter to the pages of the calendar which is critical in a determination of patentability of claim 1. (emphasis added) (A82)

It is respectfully submitted that the Board too narrowly defined the structure with which the printed matter must have a functional relationship.

That is, the structure is simply the pages of the calendar acting as a mere substrate. However, it is the relationship with the “underlying object” as stated in Ngai which is critical. That is, it is the functionality of the recipient’s name in combination with the pages of the daily calendar and the other printed matter imprinted thereon, i.e., the enterprise identifier, which must be evaluated. The Board recognized that the printed name of a person in juxtaposition with the enterprise identifier on each page of a daily calendar creates a mental association which is reinforced each day when the recipient turns to a new page of the calendar.

This, as the Board admits, is a new and unobvious functional relationship between the printed matter and the underlying object. This is a necessary conclusion since the recipient’s printed name alone on a page would not create this mental association effect central to the promotional purpose of the invention, and thus the content of the printed matter is essential in producing the effect intended.

C. THE PRINTED MATTER IN METHOD CLAIMS 4 AND 5 SHOULD BE GIVEN PATENTABLE WEIGHT

1. Method Claims Are Not Subject To The Nonfunctionality Test

It will be appreciated that all of the decisions discussed above deal with a combination of printed matter with articles of manufacture. The premise of the test is whether claimed content of printed matter in a combination with other structure can be deemed to establish patentability of the combination.

Claims 4 and 5 recite a method for promoting an enterprise including a step involving prominently printing the name of an individual on each page of a daily calendar having a separate page for each day and also imprinting an enterprise identifier on each page of the calendar so as to visually associate the name and enterprise identifier and distributing these calendars to the individuals. To apply the non-functionality test to a method would constitute a liberal use of “printed matter” rejections, which is not favored, In re Lowry, supra. In MPEP 2106, VI it is suggested that the test applies to methods, but no case law is cited in support of that proposition.

2. Even If Subject To The Nonfunctionality Test, Claims 4 And 5 Recite Printed Matter Which Is Functionally Related To The Other Steps Of The Claimed Method

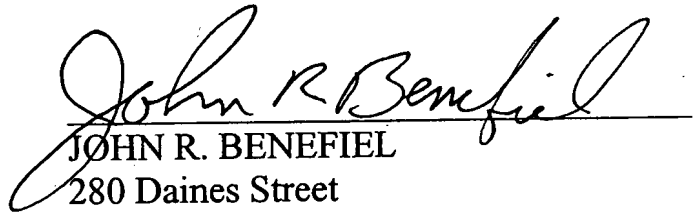
Again, the content of the printed matter, i.e. the recipient’s name and the enterprise identifier, are essential to the result sought to be achieved by method, promoting the enterprise by creating a visually induced mental association between the recipient and the enterprise. Even the distributing step is tied to the particular named individuals. Thus, even if the non-functionality

test is extended to method claims, claims 4 and 5 recite steps involving printed matter the content of which is functionally related to the other steps of the method.

CONCLUSION

All of the appealed claims 1-5 are patentable when the recited content of printed matter is properly given patentable weight, and reversal of the Decision of the Board of Patent Appeals and Interferences dated December 15, 2005 affirming the Examiner's Rejection of claims 1-5 is respectfully urged.

Respectfully submitted,

A handwritten signature in cursive script, reading "John R. Benefiel", is written over a horizontal line.

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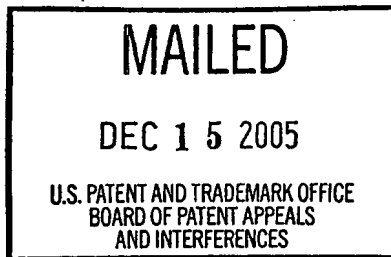
ADDENDUM

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte PAUL C. ZIMMER



Appeal No. 2005-2375
Application No. 09/612,821

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to the appellant's request for rehearing¹ of our decision mailed October 25, 2005, wherein we affirmed the examiner's rejection of claims 1 to 5 under 35 U.S.C. § 103.²

¹ Filed November 25, 2005.

² The Notice of Abandonment, mailed November 2, 2005, is obviously premature since the appellant has two months from the date of our decision to seek rehearing (i.e., reconsideration). 37 CFR 41.52.

One issue (pp. 3-4) raised by the appellant is that a functional relationship exists between the calendar and the imprint of a person's name and should be given patentable weight. We have carefully considered the arguments presented by the appellant in support of this issue but those arguments do not persuade us that our decision was in error in any respect. It remains our view (decision, pp. 4-5) that (1) the only differences between the instant invention and the Hallam calendar is the content of the printed matter placed on each page of the calendar; and (2) there does not exist any new and unobvious functional relationship between the printed matter and the substrate.³

Another issue (pp. 1-3) raised by the appellant is that in view of the different basis for the affirmance of the rejection than that put forth by the examiner the appellant requests that he be allowed to withdraw the grouping of claims 1 to 5 together and that the Board specifically consider claims 4 and 5 on their merits.

We have reviewed claims 4 and 5 on their merits and see no reason why they would be patentable over the Hallam calendar. Once again, the only differences between the instant invention as set forth in claims 4 and 5 and the Hallam calendar is the content of the printed matter placed on each page of the calendar and there does not exist any

³ Our reviewing court has stated that where the differences between the claimed invention and the prior art resides in printed matter, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. In re Ngai, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004); In re Gulack, 703 F.2d 1381, 1386, 217 USPQ 401, 404 (Fed. Cir. 1983)

and unobvious functional relationship between the printed matter and the substrate.

Accordingly, the decision of the examiner to reject claims 4 and 5 under 35 U.S.C. § 103 was correct.

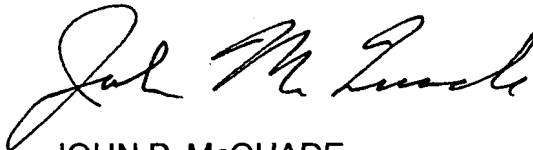
In light of the foregoing, the appellant's request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change in our decision to affirm the rejection of claims 1 to 5 under 35 U.S.C. § 103.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

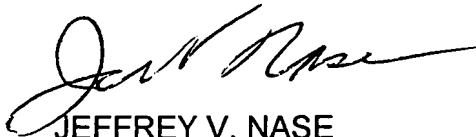
REQUEST FOR REHEARING - DENIED



CHARLES E. FRANKFORT
Administrative Patent Judge



JOHN P. McQUADE
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge

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Appeal No. 2005-2375
Application No. 09/612,821

Page 8

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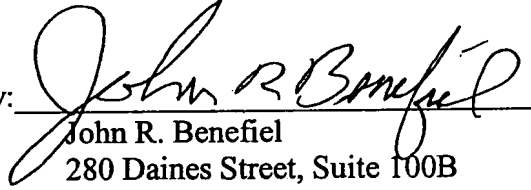
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that two true and correct copies of the
Appellant's Brief have been served on counsel as follows this 30th day of May, 2006:

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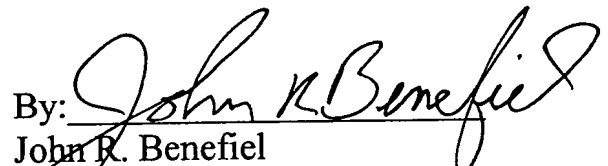
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The undersigned hereby certifies that two true and correct copies of
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